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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/510,094

12/08/2004

Kia Silverbrook

BAL20US

6892

24011 7590 04/13/2007  
SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

SUTHAR, RISHI S

ART UNIT

PAPER NUMBER

2851

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/510,094	SILVERBROOK, KIA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rishi Suthar	2851	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20070108</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 December 2006 has been entered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "expansive magnetic recording surface which is at least the same size as said printed image" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claim 1 recites the limitation "said printed image" in lines 7-8 of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 5,847,836) in view of Hatada et al. (US 4,270,853), Sharma et al. (US 5,726,693) and Robison (US 5,194,892).

Suzuki discloses in Figs. 1 and 2 and column 4, line 29 through column 6, line 15, a camera system with an image sensor (40), a digital processing means (26), and a printer with a detachable print media supply means or a print sheet roll (25) wrapped around a former which rotates when the camera system is printing, and a print head (5). However, Suzuki does not disclose photo width printing where the print media is treated to be magnetically sensitive including an expansive magnetic recording surface and a magnetic recording means. Hatada et al. discloses in Figures 1a, 1b, 2, 9 and 10 and column 2, line 14 through column 3, line 7 and column 9 through column 10, line 53, a camera system with a sensor for sensing an image and printing the sensed image where there is a first surface for the printing the image (2) and a second surface which is a magnetically sensitive surface (9) and magnetic recording means for recording audio information associated with the image onto the magnetically sensitive surface. Hatada et al. also teaches that the magnetically sensitive surface comprises a strip affixed to the back or the front of the print media (col. 2, line 65 – col. 3, line 7). Sharma et al. discloses in Fig. 1, a photo width ink jet printing (col. 5, lines 52-63). Robison discloses in Figures 1a and 1b a photo media being treated to include an expansive magnetic recording surface the same size of the image. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the photo width printing and the treated and expansive magnetic recording portion for audio to the invention of Suzuki in order to enhance the enjoyment and to provide additional information when viewing the image through the magnetic recording, and to simplify the mechanism and to obtain very small spot sizes, and very low power

dissipation and high accuracy of the photo width printing (Sharma et al., col. 4), and to enable high density recording anywhere on the media for increased storage (Robison, col. 2, lines 44-61).

6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 5,847,836) in view of Kelley (US 4,905,029), Sharma et al. (US 5,726,693) and Robison (US 5,194,892).

Suzuki discloses in Figs. 1 and 2 and column 4, line 29 through column 6, line 15, a camera system with an image sensor (40), a digital processing means (26), and a printer with a detachable print media supply means or a print sheet roll (25) wrapped around a former which rotates when the camera system is printing, and a print head (5). However, Suzuki does not disclose photo width printing where the print media is treated to be magnetically sensitive including an expansive magnetic recording surface and a magnetic recording means. Kelley discloses in Figures 1, 4 and 6 and column 1, line 48 - column 2, line 7, a camera system (Fig. 1) with a sensor for sensing an image and printing the sensed image where there is a first surface for the printing the image (22) and a second surface which is a magnetically sensitive surface (24) and magnetic recording means for recording audio information associated with the image onto the magnetically sensitive surface. Kelley also teaches that the magnetically sensitive surface comprises a strip affixed to the back or the front of the print media (col. 6, line 67 - col. 7, line 3). Sharma et al. discloses in Figure 1, a photo width inkjet printing (col. 5, lines 52-63). Robison discloses in Figures 1a and 1b a photo media being treated to

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include an expansive magnetic recording surface the same size of the image.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the photo width printing and the treated and expansive magnetic recording portion for audio to the invention of Suzuki in order to enhance the enjoyment and to provide additional information when viewing the image through the magnetic recording, and to simplify the mechanism and to obtain very small spot sizes, and very low power dissipation and high accuracy of the photo width printing (Sharma et al. col. 4), and to enable high density recording anywhere on the media for increased storage (Robison, col. 2, lines 44-61).

### ***Response to Arguments***

7. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.


### ***Telephone Numbers***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rishi Suthar whose telephone number is 571-272-8456. The examiner can normally be reached on M-F 8:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diane Lee can be reached on 571-272-2399. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rishi Suthar  
Examiner  
Art Unit 2851

RS  
April 7, 2007

William Perkey  
Primary Examiner